



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,574	06/22/2001	Henry C. Yuen	36179/WWM/11	9100

7590 04/20/2006

Alexander Shvarts
Fish & Neave
1251 Avenue of the Americas
New York, NY 10020-1105

EXAMINER

SALTARELLI, DOMINIC D

ART UNIT PAPER NUMBER

2623

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/807,574

Applicant(s)

YUEN, HENRY C.

Examiner

Dominic D. Saltarelli

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-16 and 20-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-16 and 20-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed February 13, 2006 have been fully considered but they are not persuasive.

First, applicant argues that Rosser does not teach "selecting any one of the advertisements from the sub-plurality of advertisements" (applicant's remarks, page 11, lines 13-21), stating that Rosser predesignates both the time and place for every commercial, pointing to col. 13, lines 13-48 (applicant's remarks, page 11, lines 22-28).

In response, Rosser teaches no such limitations on the display of commercial messages. Rosser discloses selecting an advertisement to display from a stored selection of advertisements at "an appropriate time and place for advertising insertion, which may be, but is not limited to, a conventional advertising break, or when the viewer changes channel..." (Rosser, col. 13, lines 25-28).

Second, and similarly, applicant argues that Rosser teaches away from applicant's claimed invention on the same assumption that Rosser predesignates the time and place for every commercial. However, as shown above, this simply is not taught by Rosser. Applicant's reference to "the appropriate time and place" (applicant's remarks, page 12, lines 18-22) is taken far out of context. This line from the Rosser reference is reproduced above, and shows that the context of this line is the selection of any commercial is at an "appropriate time and place"

for the showing of any commercial, as the "appropriate time and place" is listed as, for example, a conventional advertising break.

Third, applicants argue that there is no motivation to combine Rosser with Klosterman, also claiming improper hindsight (applicant's remarks, page 14, lines 13-29).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation for displaying advertisements in an EPG, as taught by Klosterman, is obvious to anyone who reads the Klosterman reference. The very purpose the Klosterman reference was even invented was to fill the need for a program guide that could display additional information, such as advertisements (Klosterman, col. 1, lines 20-63). As Rosser is a disclosure which focuses on a means for selecting advertisements when and wherever possible, it would have been quite obvious at the time to inclusively display said advertisements in an EPG as well, as shown to be desirable by Klosterman.

2. The official notice taken that it is notoriously well known in the art to restrict access to profile data stored in a receiver to any device other than the receiver, protecting the user's personal information stored in said profile from being accessed and stolen by an outside entity, such as storing the profile in separate section of memory or as a hidden file that is inaccessible from any computer connected to the receiver over a network, was not traversed by the applicant, and is thus taken as an admission of the fact herein.
3. The official notice take that it is notoriously well known in the art to maintain a count of viewed category information in systems that create and maintain viewer profiles was not traversed by the applicant, and is thus taken as an admission of the fact herein.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-5, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosser in view of Klosterman et al. (5,940,073) [Klosterman].

Regarding claims 1, 15, and 16, Rosser discloses a method and system for targeting advertisements to television viewers (col. 13, lines 13-48) that have a television receiver (fig. 1, set top device 44) and a television screen (fig. 1, video screen 56), the method comprising the steps of:

Art Unit: 2623

monitoring use of the receiver to develop a viewer profile based on viewer selections (col. 8, lines 4-19 and col. 9 line 49 – col. 10 line 5 and col. 11 line 62 – col. 12 line 16);

receiving a plurality of advertisements with a television signal at the receiver (col. 13, lines 19-23);

selectively storing a sub-plurality of the received advertisements at the receiver depending on the viewer profile (the receiver device strips off the inserted information, col. 7, lines 46-58, wherein the advertisement data stripped off and stored, col. 13, lines 13-25, are selectively filtered stored for display, since the profile generated is used by the receiver to identify those advertisements specifically of interest to the particular household, col. 3, lines 26-62);

selecting any one of the advertisements from the sub-plurality of stored advertisements (for example, during a conventional commercial break, or when the user changes the channel, one of the stored advertisements are selected for display, col. 13, lines 25-33); and

displaying the selected advertisement advertisements on the screen (col. 13, lines 25-33).

Rosser fails to disclose displaying an EPG on the television screen.

In an analogous art, Klosterman teaches displaying an electronic program guide (fig. 4a), providing users with a means to locate and select specific programming.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method and system disclosed by Rosser to include displaying an EPG on the television screen, as taught by Klosterman, for the benefit of displaying an electronic program guide that provides users with a means to locate and select programming of interest.

Regarding claim 3, Rosser and Klosterman disclose the method of claim 1, wherein the received advertisements are embedded in a television signal (Rosser, col. 12, lines 19-23).

Regarding claim 4, Rosser and Klosterman disclose the method of claim 3, wherein the receiver receives an analog broadcast (Rosser, col. 7, lines 59-66), and the received advertisements are embedded in the VBI (Rosser, col. 4, lines 15-30 and col. 6, lines 49-67).

Regarding claim 5, Rosser and Klosterman disclose the method of claim 3, wherein the television signal is formatted as a digital video stream (Rosser, col. 7, lines 59-66), wherein the received advertisements are embedded in the video stream (col. 6, lines 49-67, wherein the graphics and video for insertion are included as digitally compressed video signal in an appropriate cosignal such as a spare audio channel).

Art Unit: 2623

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosser and Klosterman as applied to claim 1 above, and further in view of Dedrick (5,724,521, of record).

Regarding claim 6, Rosser and Klosterman disclose the method of claim 1, but fail to disclose maintaining the viewer profile in a secure file at the receiver.

In an analogous art, Dedrick teaches storing person profile information in a secure file (profile is encrypted to protect it from being accessed by any other user, col. 7, lines 37-49), preventing access to sensitive information that may be in the user's profile (col. 7, lines 16-25 lines 37-49).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rosser and Augenbraun to include maintaining the viewer profile in a secure file at the receiver, as taught by Dedrick, for the benefit of protecting the viewer related information stored in the profile.

7. Claims 7, 8, and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosser and Klosterman as applied to claim 1 above, and further in view of Rothmuller (5,635,989, of record).

Regarding claims 7, 11, 12, and 13, Rosser and Klosterman disclose the method of claim 1, wherein program category identifiers are associated with programming (Rosser teaches associating 'program category codes' with programs, col. 7, lines 46-58), but fail to disclose storing an EPG database at the

receiver, the EPG database including the time, channel, and program category identifiers of telecast television programs, the EPG displaying step permits viewers to highlight displayed program listings to initiate another action, and the monitoring step retrieves the program categories of telecast television programs selected by the viewer for display on the screen from the EPG database by addressing the time (from using a real time clock) and channel (from monitoring the tuner) of such selected television programs.

In an analogous art, Rothmuller teaches storing an EPG database at a receiver (col. 3 line 60 – col. 4 line 16), the EPG database including the time and channel of telecast television programming (see fig. 2), wherein users are permitted to select programs by highlighting them in the displayed guide (col. 4 line 66 – col. 5 line 3), wherein a monitoring step also takes place by retrieving title information of the programs selected by the viewer for display on screen from the EPG database by addressing the time and channel of such selected television programs (col. 5 line 59 – col. 6 line 22), helping to determine viewing preferences of a user (col. 5, lines 52-58).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rosser and Klosterman to include storing an EPG database at the receiver, the EPG database including the time and channel of telecast television programming, the EPG displaying step permits viewer to highlight displayed program listings to initiate another action, wherein the monitoring step retrieves information of the programs selected by the viewer

for display on screen from the EPG database by addressing the time and channel of such selected television programs, as taught by Rothmuller, for the benefit of helping to determine viewing preferences of a user. The EPG database also includes the program category information, since the information being compiled to determine user preferences is category information, as taught by Rosser in col. 8, lines 35-38 and shown in figs. 3 and 5.

Regarding claim 8, Rosser, Klosterman, and Rothmuller disclose the method of claim 7, wherein the monitoring step additionally records the time that programs in each category are displayed (Rosser, fig. 3) and the storing step stores an advertisement that matches the category having the longest recorded time (Rosser teaches the categories having the longest recorded times are of the most interest to the user, col. 8 line 56 - col. 9 line 16).

Regarding claim 14, Rosser, Klosterman, and Rothmuller disclose the method of claim 13, and Rosser further suggests including additional factors to assist in the weighting of 'viewing intensity' associated with categories, which determine viewer interest in said categories (col. 9 line 49 – col. 10 line 5), but they fail to teach the monitoring step counts by category the number of times the other action is initiated.

It is notoriously well known in the art to maintain a count of viewed category information in systems that create and maintain viewer profiles.

Examples include systems that count the number of programs that fall within particular genres to determine a favorite genre of the viewer, or systems that count the number of programs that include a particular actor to determine the favorite actor of the viewer.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rosser, Klosterman, and Rothmuller to include counts by category the number of times the other action is initiated, for the benefit of providing an additional factor to assist in creating a more accurate profile of a viewer (a weighting factor for adjusting 'viewing intensity').

8. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosser, Klosterman, and Rothmuller as applied to claim 7 above, and further in view of Young et al. (5,353,121, of record) [Young].

Regarding claim 9, Rosser, Klosterman, and Rothmuller disclose the method of claim 7, but fail to disclose the EPG displaying step uses the same program category identifiers to compile category program guides.

In an analogous art, Young teaches compiling category program guides for display in an EPG (figs. 14-17), for the benefit of providing theme based guides to assist users in locating desired programming.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rosser, Klosterman, and Rothmuller to include compiling category program guides, as taught by Young, wherein the

displaying step uses the same program category identifiers to perform said compiling (movies, sport, specials, and TV fare are used consistently, shown in figs. 14 through 17 of Young).

Regarding claim 10, Rosser, Klosterman, and Rothmuller disclose the method of claim 7, but fail to disclose the EPG displaying step uses different program category identifiers to compile category program guides.

In an analogous art, Young teaches compiling category program guides for display in an EPG (figs. 14-17), for the benefit of providing theme based guides to assist users in locating desired programming.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rosser, Augenbraun, and Rothmuller to include compiling category program guides, as taught by Young, wherein the displaying step uses different program category identifiers to perform said compiling (the different category identifiers include movies, sport, specials, and TV fare, shown in figs. 14 through 17 of Young).

9. Claims 20, 21, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosser in view of Dedrick and Klosterman.

Regarding claims 20 and 24, Rosser discloses a method and system of collecting viewer profile data for a television receiver comprising:

monitoring use of the television receiver to develop a viewer profile based on viewer selections (col. 7 line 59 - col. 8 line 19);

receiving a plurality of advertisements with a television signal at the receiver (col. 13, lines 19-23);

storing a sub-plurality of the received advertisements at the receiver depending on the viewer profile (the receiver device strips off the inserted information, col. 7, lines 46-58, wherein the advertisement data stripped off and stored, col. 13, lines 13-25, are selectively filtered stored for display, since the profile generated is used by the receiver to identify those advertisements specifically of interest to the particular household, col. 3, lines 26-62);

selecting any one of the advertisements from the sub-plurality of stored advertisements (col. 13, lines 25-33); and

displaying the selected advertisement (col. 13, lines 25-33).

Rosser fails to disclose storing the results in a secure file and displaying the selected advertisement on a screen in an EPG.

In an analogous art, Dedrick teaches storing person profile information in a secure file (profile is encrypted to protect it from being accessed by any other user, col. 7, lines 37-49), preventing access to sensitive information that may be in the user's profile (col. 7, lines 16-25 lines 37-49).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method and system disclosed by Rosser to include maintaining

the viewer profile in a secure file, as taught by Dedrick, for the benefit of protecting the viewer related information stored in the profile.

Rosser and Dedrick fail to disclose displaying the selected advertisement on a screen in an EPG.

In an analogous art, Klosterman teaches displaying an electronic program guide (fig. 4a), providing users with a means to locate and select specific programming.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method and system disclosed by Rosser and Dedrick to include displaying an EPG on the television screen, as taught by Klosterman, for the benefit of displaying an electronic program guide that provides users with a means to locate and select programming of interest.

Regarding claims 21 and 25, Rosser, Dedrick, and Klosterman disclose the method and system of claims 20 and 24, but fail to disclose storing the results further comprises storing the results in a secure file in which the data cannot be accessed from outside the television receiver.

It is notoriously well known in the art to restrict access to profile data stored in a receiver to any device other than the receiver, protecting the user's personal information stored in said profile from being accessed and stolen by an outside entity, such as storing the profile in separate section of memory or as a

hidden file that is inaccessible from any computer connected to the receiver over a network.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method and system disclosed by Rosser, Dedrick, and Klosterman to include storing the results in a secure file in which the data cannot be access from outside the television receiver, protecting the user's personal information stored in said profile from being accessed and stolen by a malicious outside entity.

10. Claims 22, 23, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosser and Dedrick as applied to claims 20 and 24 above, and further in view of O'Flaherty et al. (6,253,203, of record) [O'Flaherty].

Regarding claims 22 and 26, Rosser, Dedrick, and Klosterman disclose the method and system of claims 20 and 24, but fail to disclose storing the results further comprises storing the results in a secure file from which only anonymous data can be accessed from outside the television receiver.

In an analogous art, O'Flaherty teaches restricting access by third parties to a locally stored database to only being able to access anonymous data for the benefit of enhancing privacy of personalized information yet maintaining controlled access to the data for the benefit of the third parties (col. 4, lines 30-53).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method and system disclosed by Rosser, Dedrick, and Klosterman to include a secure file from which only anonymous data can be accessed from the outside, as taught by O'Flaherty, for the benefit of enhancing privacy of personalized information yet maintaining controlled access to the data for the benefit of interested third parties.

Regarding claims 23 and 27, Rosser, Dedrick, Klosterman, and O'Flaherty disclose the method and system of claims 22 and 26, wherein the anonymous data is accessed from outside the television receiver by telephone (Rosser, col. 8, lines 45-50).

11. Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosser and Klosterman as applied to claims 1 and 15 above, and further in view of Marsh et al. (5,848,397) [Marsh].

Regarding claims 28 and 29, Rosser and Klosterman disclose the system and method of claims 1 and 15, but fail to disclose the advertisement is selected from the sub-plurality of advertisements according to a rotation.

In an analogous art, Marsh teaches displaying selected advertisements according to a rotation (col. 9, lines 7-27), for the benefit of maintaining a fair distribution of the display of advertisements (col. 9, lines 50-64).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method and system of Rosser and Klosterman to include selecting the advertisements according to a rotation, as taught by Marsh, for the benefit of maintaining a fair distribution of the display of advertisements.

12. Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosser, Dedrick, and Klosterman as applied to claims 20 and 24 above, and further in view of Marsh.

Regarding claims 30 and 31, Rosser, Dedrick, and Klosterman disclose the system and method of claims 20 and 24, but fail to disclose the advertisement is selected from the sub-plurality of advertisements according to a rotation.

In an analogous art, Marsh teaches displaying selected advertisements according to a rotation (col. 9, lines 7-27), for the benefit of maintaining a fair distribution of the display of advertisements (col. 9, lines 50-64).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method and system of Rosser, Dedrick, and Klosterman to include selecting the advertisements according to a rotation, as taught by Marsh, for the benefit of maintaining a fair distribution of the display of advertisements.

Conclusion

Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents

Art Unit: 2623

P.O. Box 1450
Alexandria, VA 22313-1450

on _____
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Registration Number: _____

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) _____ - _____ on _____.
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Registration Number: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic D. Saltarelli whose telephone number is (571) 272-7302. The examiner can normally be reached on Monday - Friday 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dominic Saltarelli
Patent Examiner
Art Uni 2611

DS



JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600